

REMARKS

Reconsideration of this application is respectfully requested.

In a sincere effort to advance prosecution, Applicants have changed the pending claims as follows. Claims 150 and 183 have been amended. Claim 184 has been cancelled in favor of new claim 185 which has been added. In addition, claims 151 and 141 have been cancelled above. After entry of the above-mentioned amendments, claims 126-130, 134-136, 142-143, 150, 152-183 and 185 will be presented for further examination in the application.

Claim 150 has been amended as follows. Step (a) in claim 150 now calls for "contacting under hybridizable conditions" said sample with at least one compound . . ." In claim 151 as now amended, step (a) calls for "contacting under binding conditions said sample with a compound . . ." In addition, any reference to the base element B as representing a purine, or to the attachment of A to the 8-position of a purine, is not addressed in claims 150. Applicants expressly retain the right to pursue the subject matter of the C-8 purine modification in a duly filed continuation application.

Claim 183 has been amended above by substituting the correct chemical structural formula found in the instant specification on page 11, penultimate line.

Claim 185 has been added above in place of claim 184, the latter having been cancelled above. Claim 185 recites "the method of claim 130 wherein when said microorganism is Streptococcus pyogenes or Neisseria meningitidis, said antibiotic is penicillin, wherein when said microorganism is Staphylococcus aureus, Candida albicans, Pseudomonas aeruginosa, Streptococcus pyogenes, or Neisseria gonorrhoeae, said antibiotic is a tetracycline, and wherein when said microorganism is Mycobacterium tuberculosis, said antibiotic is an aminoglycoside." Support for the subject matter of claim 185 is found in the instant specification, page 29, penultimate paragraph.

As noted above, claim 151 (and claim 141 dependent therefrom) have also been cancelled in this application without prejudice or disclaimer to Applicants' right to pursue the subject matter of these claims in a subsequent duly filed continuation application. These

claims were directed to a method for determining the presence or absence of cells having hormone receptor sites on the surfaces thereof in a sample.

Applicants would like to respectfully point out that none of the foregoing amendments raise new issues that would require further consideration and/or search, or raise the issue of new matter, or present additional claims without cancelling a corresponding number of finally rejected claims. Furthermore, Applicants respectfully submit that the foregoing amendments place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

Before addressing the issues in the instant Office Action, Applicants and their attorneys appreciate the indication from the Examiner that any rejections and/or objections not reiterated from the previous (September 29, 1992) office action have been withdrawn, and moreover, that the instant claims are allowable over the prior art of record for reasons of record.

Applicants and their attorney also appreciate the courtesy extended by the Examiner in the May 19, 1993 interview held at his office during which the few outstanding issues in the application were discussed.

It is believed that the claims presented for further examination in this application clearly obviate all the remaining issues as set forth in the instant Office Action.

The Objection and Rejection Under 35 U.S.C. §112,

First Paragraph

On page 2 of the Office Action, the specification was objected to under 35 U.S.C. §112, first paragraph, as not providing support, as originally filed, for the invention as now claimed. The Examiner stated that "Claim 184 does not limit each resistance gene practice to specific microorganisms as originally filed and thus contains NEW MATTER in this increased scope indicating that any of the microorganisms contain any of the cited resistance genes."

As noted above, in place of claim 184 (now cancelled), claim 185 has been added which reflects the subject matter of page 29 (penultimate paragraph) in the instant specification. Thus, no new matter has been entered by the new claim. It is believed that new claim 185 meets the Examiner's rejection in the instant Office Action (page 2) by designating the recited microorganism viz-a-viz the resistance genes. Although Applicants have substituted a new claim (185) for the now cancelled claim (184), they nevertheless expressly retain the right to pursue subject matter directed to antibiotic drug resistance in general for all etiological agents in a subsequent and duly filed continuation application.

In view of the cancellation of claim 184 in favor of new claim 185, Applicants respectfully request reconsideration and withdrawal of the objection and rejection under §112, first paragraph.

The Rejection Under 35 U.S.C. §112, First Paragraph

Claims 126-130, 134-136, 141-143 and 150-184 stand rejected under 35 U.S.C. §112, first paragraph, as the disclosure is allegedly enabling only for claims limited to modification of purines (claims moiety B) only at the 7-position of 7-deazapurines or modification of pyrimidines (claim moiety B) at the 5-position. The Examiner's remarks are set forth on page 3 of the instant Office Action.

As noted in the opening remarks of this Amendment, claims 150 and 151 have each been amended so that reference to the C-8 modification of a purine is not addressed. Applicants feel compelled to reiterate their intent to pursue the subject matter of the C-8 purine modification in a future continuation application. With the foregoing deletions to claims 150 and 151, it is believed that the ground of rejection for non-enablement has been obviated. Reconsideration and withdrawal of the rejection is respectfully requested.

The Rejection Under 35 U.S.C. §112, Second Paragraph

On page 3 of the instant Office Action, claim 183 stands rejected for indefiniteness under §112, second paragraph. The Examiner astutely observed on pages 3 and 4 that "the triple bonded oxygen and triple bonded carbon atoms given in the structure . . . appears to be

incorrect in that the hydroxyl probably should be directed to the triple bonded carbon thus making it bonded to four atoms and also making the oxygen bonded to only two atoms. . ."

In response to this rejection, Applicants have substituted the correct structure in claim 183. Reconsideration and withdrawal of the indefiniteness rejection is respectfully requested.

In view of the foregoing amendments, it is respectfully submitted that each of the claims presently under examination, 126-130, 134-136, 142-143, 150, 152-183 and 185, is in allowable condition. Favorable action is earnestly solicited.

In order to expedite review, Applicants' undersigned attorney has arranged for their Washington associates to file this Amendment in person with the clerk of Group 1800.

* * * * *

SUMMARY AND CONCLUSIONS

Claims 126-130, 134-136, 142-143, 150, 152-183 and 185 are presented for further examination in this application. Claims 150 and 183 have been amended; and claim 185 has been added. Claims 151, 141 and 184 have been cancelled by this Amendment. No new matter has been introduced by any of the amendments to the claims or by the claim added hereinabove.

This Amendment is being timely filed. Although no fee is due, The U.S. Patent and Trademark Office is nevertheless hereby authorized to charge Deposit Account No. 05-1135 for any fees required in connection with this Amendment and to credit any overpayment thereto.

In view of the above amendments and discussion of the issues, Applicants respectfully submit that each of claims 126-130, 134-136, 142-143, 150, 152-183 and 185 is in condition for allowance. A favorable and speedy reconsideration of their rejection is requested. If any of these claims are found not to be in condition for allowance for any reason, the Examiner is respectfully requested to telephone the undersigned at (212) 856-0876, to discuss the subject application.

Respectfully submitted,



Ronald C. Fedus
Registration No. 32,567
Attorney for Applicants

ENZO DIAGNOSTICS, INC.
c/o Enzo Biochem, Inc.
575 Fifth Avenue (18th Floor)
New York, New York 10017
Tel. (212) 856-0876

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FILED IN PERSON: JULY 30, 1993

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